

REMARKS

Claims 51, 52 and 59-80 are in the case. Claims 51, 52 and 71-80 were allowed in the previous Office Action. Claims 59-70 are still at issue in this case. In the prior reply to the Final Office Action mailed April 12, 2006, Applicant amended claims 59 and 65-70 following the Examiner's suggestion that the apparatus is directed to a screen printing machine. While Applicant believes these prior amendments have now overcome and patentably distinguish over the prior art cited by the Examiner and cited in the file history, Applicant puts forth the following arguments to traverse the latest rejection of claims 59-70.

Independent Claims 59 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US 5,921,176) in view of Iwamoto et al. (JP 2000203034) publication and Rivin (US Publication 2003/0185624).

First, the Oleson (US Patent 5,921,176) (hereinafter "Oleson") lacks any reference to the problem of placing shims of the same size and thickness on opposing frame holders. Examiner's reference to Oleson teaching a frame (3) holding a screen (12) and one or more frame holders (10) for supporting each screen (12) above the item (T) includes incorrect numeral designation of the elements therein. The screen frame is referred to as numeral (10) not as numeral (3), columns 3 and 8, lines 64-67 and 8-25, respectively. Moreover, the numeral (3) refers to the holes in carrier polyester sheet (3) aligning with corresponding holes on the exposure frame (30) in FIGS. 2 and 3. The carrier sheet (3) does not support the portable screen frames (10) with the screen (12) therein but the opposing flanges (23) of FIG. 4 within the printing head H in FIG. 1 support the screen frames (10) above the item (T) in FIG. 1.

Therefore, each screen (12) is within a portable screen frame (10) that is supported above the item (T) by two opposing flanges (23), column 8, Lines 8-25. Nevertheless, Applicant agrees with the Examiner that the Oleson reference does not teach or even suggest the invention of Claims 59 and 65.

Now referring to Iwamoto et al. (JP2000203034) (hereinafter "Iwamoto"), it is rather unclear exactly what it teaches to one skilled in the art. In order to rely on this reference for a 103(a) rejection, the Examiner must first determine what is "analogous prior art" for the purpose

of analyzing the obviousness of the subject matter at issue. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) (“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

Applicant believes this Iwamoto reference fails on all accounts. Iwamoto is maybe in an analogous art field even though the skimpy description and drawings hardly show much at all but it definitely does not teach or suggest the Applicant’s invention found in claims 59 and 65. Iwamoto refers to screen printing of a glass substrate (1) for a plasma display. The assistant runner (2) does not appear to perform the same function as the flanges (23) in Oleson so Applicant is questioning whether this is analogous prior art. For argument sake, let us assume that the assistant runner (2) is the equivalent to the flanges (23) in Oleson. The flanges (23) hold the screen frames (10) with the printing screen (12). Moreover, the runner (2) is adjusted to be below the glass substrate (1), Lines 16-32, where the screen printing takes place. In short, how do you place and maneuver the flanges (23) of Oleson to be below item (T) when the flanges (23) are connected to the printing head H above item (T) and still be able to do any printing. The suggestion that Iwamoto runner and the disclosure therein is the same as the printing press and the screen-printing of Claims 59 and 62 is simply a physical impossibility to function in the same manner where the runner (2) is located below the item (T) to be printed.

It appears from the description in Lines 16-32 of Iwamoto, that the screen-printing is on the glass substrate (1), which is located above the runner (2) and a shim spacer is placed between

the runner (2) and the printing table (3). Also, there is no mention of the shim under runner (2) having a “generally uniform predetermined thickness” or a reference to the use of multiple shims of uniform thickness as called for in the structural features of claims 59 and 65. In short, this is hardly analogous prior art to the Applicant’s endeavor. Nor is this Iwamoto reference reasonably pertinent to the problem solved by Applicant’s invention for the reasons as stated above even though it may talk about vertical adjustments of the runner (2) by shims not disclosed or shown in the reference, which are placed under the runner (2).

On the other hand, Rivin (US Publication 2003/0185624) (hereinafter “Rivin”) is totally a non-analogous art showing what appears to be shear elastomeric shims used in conjunction with wedges for solving a frictional problem within a machine tool. The problem solved in Applicant’s invention has nothing to do with frictional losses in a machine tool or mechanism. Since these shims are used in conjunction with wedges in the chuck of a machine tool, there is no way that they can be inserted into the flanges (23) of Oleson or place underneath the runner (2) in Iwamoto to produce the desired function of the claimed elements in claims 59 and 65.

Assuming for argument that the Rivin reference maybe reasonably pertinent if, even though it may be in a different art field from that of the inventor’s endeavor, it is one, which, because of the subject matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem. Here, an ordinary person skilled in the art of printing T-shirts and the like would not even think about using replaceable shear deformation elastomeric shims used in combination with wedges in the chuck of a tool such as a drill mechanism shown in Fig. 5 to effectively reduce frictional losses in the machine tool mechanism. In Rivin the shims (12) and (13) used in conjunction with a wedge (2) in Fig. 2 are not used for height adjustments in the tool mechanism but are simple used to reduce frictional losses in the tool mechanism. There is nothing in the Rivin specification or teachings that are even closely analogous to the problem solved by the present claimed invention.

And finally with regard to claims 59 and 65, Applicant respectfully traverse the rejection of claims 59 and 65 because there is nothing in the teaching or suggestions in Oleson in view of Iwamoto and Rivin showing multiple shims used in pairs or sets having a uniform thickness to achieve the spacing of a printing screen frame holding the printing screen a predetermined distance about the item to be printed as the structure spelled out in the elements of these two

claims. Also, none of the references either alone or in combination teach the use of multiple shims for adjusting the height of the tool to facilitate the screen printing on the clothing or other materials as called for in the claims 59 and 65. Here the height adjustment done by the claimed shims of uniform thickness is crucial to the improvement in quality printing and these claimed sets of shim elements are integral parts of the claimed invention to achieve its functionality and not merely an obvious add on or duplication of parts.

Claims 60, 63, 64, 66, 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Oleson, in view of Iwamoto and Rivin as applied claims 59 and 65 above, and further in view of Deschenes (US Publication 2002/0148172) (hereinafter “Deschenes”).

With regard to the cited references of Oleson, Iwamoto and Rivin, Applicant refers the Examiner to the above remarks. However, when these three references are taken together and further in view of Deschenes, Applicant again respectfully traverses that rejection too.

Deschenes is again totally in a non-analogous art field. This reference may still be considered analogous art by the Examiner if the subject matter disclosed therein is relevant to the particular problem with which the inventor is involved. However, the subject matter disclosed and the inherent aspect of Deschenes has absolutely nothing to do with the claims 60, 63, 64, 66, 69 and 70 either taken singly or as a group.

Deschenes teaches that rectangular blocks of wood may be cut to form attached wooden shim wedges for ease of carrying to a job site by a carpenter. The wooden wedge shaped shims are for cramming into the space between the door and window frames and the building studded framing to level and plumb these frames within the openings when the doors and windows are being installed in these studded openings. Carpentry and printing screen technology are by their very nature, not analogous art fields. Carpenters in Deschenes are looking to carry around wooden shims that they can wedge between the door or window framing and the studded opening into which it is installed. By the very nature of the spaces involved, these wooden shim cannot be of any uniform width or predetermined thickness. In fact, to use one of the wooden, wedge shaped shims, you tear it off of the rectangular block and then began inserting into the frame opening between the window or door frame and opening perimeter formed by the studs to level and square the frame in the opening before you apply fasteners to secure the door or

window frame to its opening. None of the wooden wedge shaped shims are typically used in tandem to create a uniform height between a set or pair of shims around the studded frame opening. Any person who has installed a window or door frame in a studded opening and would be skilled in that art such as a carpenter, would not be looking to adjust the height of the screen frame on a screen printing press by placing these wooden wedge shaped shims underneath or below the screen frame and between the screen frame and the frame holder to adjust the height of the screen above the item to be printed as called for in the claims 59-70.

The wooden wedge shaped shims of Deschenes are held together by not completely cutting through a rectangular block of wood, which is then turned into a multiple wedge shape shims for framing purposes. The only purpose for the wedge shaped shims is to accurately plumb and locate the door or window frame in the doorway or window opening and it has nothing to do with the height adjustment of the door or window frame. For Deschenes to be an effective reference in a 103(a) rejection, it must be pertinent to the problem solved since it is not in an analogous art field. Here the separable wedge shaped wooden shim assembly is strictly done for the convenience of the carpenter who carries around a packet of wooden wedge shaped shims that are organized instead of individual wedge shaped wooden shims.

In summary, since the wedge shaped wooden shims of Deschenes and Ingold as well as the wedge shaped elastomeric shim of Rivin are physically incapable of leveling a printing screen within opposing frame holders. Therefore, none of these three cited references teach or suggest the above-mentioned claims. These three references are from the carpentry and machine tool arts, which are not considered to be from analogous art field of screen printing presses. Thus, the cited references simply fail to make any of the claims in the invention obvious.

Therefore, Applicant respectfully traverse the rejection of Claims 60, 63, 64, 66, 69 and 70 base upon the further inclusion of the Deschenes reference with the prior references Oleson, Iwamoto, and Rivin.

Claims 61, 62, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Oleson, in view of Iwamoto, Rivin and Deschenes as applied to claims 59 and 65 above, and further in view of Ingold (US Patent 4,713, 922) (hereinafter “Ingold”).

With regard to claim 61 and 67, Ingold shows again a non-analogous art field which is not pertinent to printing press machines or screen printing wherein a building framing structure

(7) having doorway and window openings and wedge shim shaped structures (12) and (14) for accurately plumbing and locating the door and window frames within those openings, respectively. Again for this reference of Ingold to be relevant in an obviousness rejection, it must be pertinent to the problem solved by the Applicant's invention according to relevant case law. *Id.* Nailing one wedge shim to the studded frame opening for the installation of the door or window and then sliding another wedge shaped shim along the grove portions (26) of Ingold's structure, does not qualify for teaching "at least one fastener for each frame holder to interconnect the shims disposed between the frame and frame holder either to each other and/or the frame holder" for adjusting the printing screen relative to the item to be printed as called for in claims 61 and 67.

Since the claimed structure of independent claims 59 and 65 are clearly not shown by the prior art references, the addition of the Ingold reference does nothing to suggest or teach the claimed structure. These shim/spacers of Ingold would need to have uniform thickness to work similar to the claimed invention and because nothing short of a wedge shaped shim/spacer is capable of being used in plumbing and leveling doors and windows in their studded framed openings, there simply is no teaching or suggestion in this non-analogous art field that would suggest the claimed invention of using shims/spacers of uniform thickness to adjust the height for screen printing in a printing press.

Next, the prior art cited by the Examiner including the additional reference of Ingold does not obviate the claims 62 and 68. Applicant respectfully traverses this rejection of claims 62 and 68 as being unpatentable over Oleson, Iwamoto, Rivin and Deschenes in view of the teachings of Ingold. Ingold does not show the "one or more shims (spacers) in the frame holder below the frame holder and between the frame holder and the frame" as called for in claims 62 and 68. The Ingold wedge shaped, interlocking shims are located on the both sides of the studded door or window frame (7) and on top of the studded doorframe (7) beside arguably located below in a window opening but not a door opening. The location of the wedge shaped shims/spacers on the sides and on top of the door and window frame in the studded opening (assuming the studded opening to be equivalent to the frame holder) would not provide any functional purpose in the claimed invention and actually such teachings of wedge shaped carpenter shims in Ingold would not lead anyone to figuring out the unique and claimed structure found in claims 62 and 68 for a

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printing screen in a printing press. Wooden wedge shaped carpenter shims for squaring windows and doorways in wood studded openings, just do not teach or suggest the present claimed invention.

Finally, Applicant amended claims 59 and 65 to add the words "in a printing press" to the preambles to make sure the art field is clearly delineated with regard to what the claimed structure and art fields are to be applied in determining the 103(a) analogous prior art when considering an obviousness objection raised by the Examiner.

Claim 51, 52 and 71-80 are indicated as allowed and now with the amendments to the independent claims 59 and 65 and for the reasons stated above, Applicant believes it has traversed all of the rejections of the claims and early indication of allowances as to claims 59-70 is respectfully requested.

The Examiner and Commissioner are hereby authorized to charge any additional fees associated with this Response or refund any overpayment associated with this Response to our deposit account, Deposit Account No. 50-2803.

Respectfully submitted,

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